



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	450101-02844	4611

7590 01/30/2004

William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 01/30/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,023

Applicant(s)

MORITA ET AL.

Examiner

Susan Y Chen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. *1/20/04*
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Status

1. Claim 41-66 are pending for examination per the preliminary amendment filed on 10/07/2001.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) or (f), the copies of the certified copies of the priority documents have been placed of record in the application folder.

Information Disclosure Statement

3. The information disclosure statement filed on 12/16/2002 complies with the provisions of 37 CFR 1.97 1.98 and MPEP § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits. (see attached PTO-1449 form).

Specification

4. It is noted that the present specification does not contain line numbers. For ease of reference by both Examiner and Applicant all future correspondence should include the line numbering. A recommend format for numbering the claims is to number each line of each claim with a new starting line number. Also, the specification has not been

Art Unit: 2171

checked to the extent necessary to determine the presence of all possible minor errors.

Applicant cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Drawings

5. Applicant has filed informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 41, 43, 48, 50, 53, 55, 57, 60, 62 and 64, are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as '012 Bieganski).

Claims 41 and 48:

Bieganski discloses a digital data recommendation system [e.g., Fig. 1] comprising:

- means for recording usage history data and the related data recorded in the recording means based on the filtering data [e.g., the CPU (102, Fig. 1) can be coupled to the memory system (104, Fig. 1) and the secondary storage (108 of Fig. 1) to log history data indicative of usage history of the group of contents. For example, the data being stored in the History Set (203), Fig. 2; or the customer's behavior data recorded at a shopping set being specified at col. 8, lines 7-8; or the Purchased Items associated to a particular user's Transaction or the total number of Transaction being purchased of 900), Fig(s). 9; the Recommendation engine (600, Fig. 14; col. 14, lines 31-33)];
- means for computing per each of the contents a weight related to a number of checkout from the history data and the related data recorded in the recording means based on the filtering data [e.g., the compatibility modifier (200, Fig. 2) can accept a stored number of checkout (or the number of times each item was purchased, Fig. 9) per each of the contents from the history data on a filtering rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) to compute a weight related to the number of checkout (the steps 752-756, Fig. 7A)];

Art Unit: 2171

- means for selecting a content from a group of contents based on weight computed by the computing means [e.g., the user interface adapter coupled to the Input Device (114, 118, Fig 1) can be used to select the modified recommendation set based on weight computed by the compatibility modifier (Fig. 5; Fig. 6; col. 13, line 21 - col. 14, line 14; col. 14, line 31-col. 15, line 2)];
- means for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., the Display Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1) can display a list of recommended books selected by the book reviewer (col. 7, lines 49-54)].

As to claims 53, 55, 60 and 62:

these claims recite the same features as claims 41 and 48, in form of computer method / program storage medium, hence are rejected for the same reason.

As to claims 43 and 50:

Bieganski discloses all the features as claimed by applicant in claims 41 and 48. He further teaches the system having means [e.g., the User Input device (118), Fig. 1] to add new filtering data [e. g., the complement items in the shopping set, or the complement items in the historical and original

Art Unit: 2171

recommendation set are added to the recommendation process at the modules:
452-456, Fig. 4A; col. 11, lines 14-32; lines 40-56].

As to claims 57, and 64:

these claims contain the same features as their base claim and recite the same features as claims 43 and 50, in form of computer method / program storage medium, hence are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42, 44-47, 49, 51-52, 54, 56, 58-59, 61, 63, 65-66, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as Bieganski) in view of U.S. Patent No. 6,662,231 issued to Drosset et al. (hereinafter referred as Drosset).

As to claim 42:

Bieganski discloses all the features as claimed by applicant in claim 41.

Bieganski further discloses means for computing a weight related to an item per each of the contents from the related data based on the filtering data.

Furthermore, he teaches that observing a customer's shopping behavior to create a shopping set as filtering input to the compatibility modifier for guiding the modifier to apply the shopping set data as filtering criteria for computing a weight to the data item based on a particular application [e.g., col. 9, lines 63 – col. 10, line 43]. In addition, he cited his compatibility-aware system can enhance the internet audio entertainment service system with benefit of compatibility modified recommendations [col. 19, lines 55 –col. 20, line 7].

Bieganski did not expressly cite to compute a weight for a period for which the content has been checked out.

However, Drosset discloses a system providing audio service over a communication network [Drosset: Title] therein, the system measures duration for which the content has been checked out [e.g., the play-out time of Fig. 4; the step (404, Fig. 10); the step (430, Fig. 11); col. 8, line 10 – line 36].

Thus, considering the combination of Bieganski and Drosset, it would have been obvious to one of the ordinary skill person in the art at the time the invention was made to further modify the combined system of Bieganski and Drosset by computing a weight for a period for which the content has been checked out.

The ordinary skilled artisan would have been motivated to modify the combination of Bieganski and Drosset per computing a weight of a period for which the content has been checked out for the following purposes: 1) facilitating the combined system to track the cost of certain play-out time for the content has

Art Unit: 2171

been check-out from an audio entertainment service system [e.g., Drosset: Abstract, lines 7-10]; 2) using the computed weight for the duration of play-out time as a filtering rule to enhance the recommendations of the audio entertainment service system [e.g., Bieganski: Abstract, lines 5-11; col. 19, lines 55-7].

As to claim 44:

Bieganski discloses the features claimed by applicant as following:

- means [e.g., Bieganski: Fig. 1; col. 1, lines 35-40; the Recommendation engine (600), Fig. 14, col. 14, lines 31-33] for recoding related about the group of contents [e.g., Bieganski: the Purchased Items of a Transaction & total number of Transaction being purchased (900), Fig(s). 9] and filtering data intended for computation of a weight per each of the contents [e.g., Bieganski: the item compatibility rules (204), Fig. 2, col. 7, lines 21-24];
- means for computing a weight based on the filtering data [e.g., the compatibility rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) can be input to the compatibility modifier (200, Fig. 2) to compute a weight per each item of contexts; the steps: 752-756, Fig. 7A];
- means [e.g., Bieganski: the user Interface Adapter (114) or the user Input Device (118), Fig 1] for selecting a content from a

- means [e.g., Bieganski: the user Interface Adapter (114) or the user Input Device (118), Fig 1] for selecting a content from a group of contents [e.g., Bieganski: the recommendation set, col. 10, line 66] based on weight (or strength or ranking or score) [e.g. Bieganski: col. 2, line 66 - col. 3, line 7] computed by the computing means [e.g., Bieganski: the Compatibility-Aware Recommendation Engine (600, Fig. 6); col. 10, lines 14 -, lines 31-33, lines 38-49; Fig(s). 7A-B];
- means [e.g., Bieganski: the Display Adapter (112), the display (116), Fig. 1] for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., Bieganski: the displayed list of recommended books selected by the book reviewer via the user input Device (118, Fig. 1), col. 7, lines 49-54].

Bieganski did not specifically disclose computing a weight related to playing time.

However, Drosset discloses computing a playing time per each of the contents from the related data [e.g., Drosset: the step (404), Fig. 10; the step(434), Fig. 11; Fig. 4].

Thus, considering the combination of Bieganski and Drosset, it would have been obvious to one of the ordinary skill person in the art at the time the invention was made to further modify the combined system of

Bieganski and Drosset by computing a weight for a period for which the content being played.

The ordinary skilled artisan would have been motivated to modify the combination of Bieganski and Drosset per computing a weight of a period for which the content being played for the following purposes: 1) facilitating the combined system to track the cost of certain elapsed time for the content has been played from an audio entertainment service system [e.g., Drosset: Abstract, lines 7-10]; 2) using the computed weight for the duration of play-out time as a filtering rule to produce a compatibility-aware recommendation output set for the audio entertainment service system [e.g., Bieganski: Abstract, lines 5-11; col. 19, lines 55-7].

As to claim 45:

The combined system of Bieganski and Drosset discloses all the features as claimed by applicant in claim 44. Bieganski further disclose computing a weight related to the genre of the content [e.g., Bieganski: the priority ranking processing at col. 10, lines 6-17].

As to claim 46:

The combined system of Bieganski and Drosset discloses all the features as claimed by applicant in claim 44, Bieganski further discloses computing a

Art Unit: 2171

weight related to the character included in the name of the content [e.g.,

Bieganski: col. 18. line 64 – col. 19, line 3].

As to claim 47:

The combined system of Bieganski and Drosset discloses all the features as claimed by applicant in claim 44, Bieganski further discloses the system having means [e.g., the User Input device (118), Fig. 1] to add new filtering data [e. g., the complement items in the shopping set, or the complement items in the historical and original recommendation set are added to the recommendation process at the modules: 452-456, Fig. 4A; col. 11, lines 14-32; lines 40-56].

As to claim 49:

This claim draws to the same features cited in the claims: 42 and 48, hence is rejected for the same reason.

As to claims 52, 54, 56, 59, 61, 63 and 66:

These claims contain the same features as in their base claims 48, 53, 55, 60 and 62 respectively. They further recite the same feature of claim 42 except in form of computer method / program storage medium, hence are rejected for the same reason

As to claims 51, 58, and 65:

These claims contain the same features as in their base claims 48, 55 and 62 respectively. They further recite the same features as claim 45 except in form of computer method / program storage medium, hence is rejected for the same reason.

Conclusion

8. To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,645,067 issued to Okita et al., which disclosed an audio/video system to provide entertainment service to client; U.S. Patent No. 6,173,280 issued to Ramkumar et al., which disclosed a data mining system to generate weighted association rules.

Inquiry

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

Art Unit: 2171

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-3900.

Susan Chen
Jan. 22, 2004

MSC 1/22/04